

REMARKS

Claims 1-20 are pending in the application, of which, claims 1, 7, 11, and 18 have been amended. No new matter has been added by way of the foregoing amendments. Support for the foregoing amendments can be found in at least paragraphs [0020-24] of the present application. Reconsideration of presently pending claims 1-20 is respectfully requested in light of the above amendments and the following remarks.

Rejections under 35 U.S.C. § 103

The Office Action indicated that claims 1-20 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Ho et al. (U.S. Patent No. 6,915,352 hereinafter referred to as “Ho”) in view of Spindel et al. (U.S. Patent No. 4,574,362 hereinafter referred to as “Spindel”). Applicant traverses the rejection of claims 1-20 on the grounds that the Ho and Spindel references are defective in establishing a *prima facie* case of obviousness with respect to claims 1-20.

In *KSR Int'l. Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1739 (2007), the Court stated that “a patent composed of several elements **is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art.** Although common sense directs one to look with care at a patent application that claims as innovation the combination of two known devices according to their established functions, it can be important to identify a **reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does.** This is so because inventions in most, if not all, instances rely upon building blocks long since uncovered, and claimed discoveries almost of necessity will be combinations of what, in some sense, is already known.” *Id.* at 1741 (emphasis added).

As the PTO recognizes in MPEP § 2142:

The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.

In the present application, a *prima facie* case of obviousness does not exist for the claims as herein amended for the reasons set forth below.

Independent Claim 1

1. The References Are Not Properly Combinable If Their Intended Function Is Destroyed.

It is clear that the Ho and Spindel patents are not properly combinable since, if combined, their intended function is destroyed. More particularly, if the Ho reference “insert[ed] an identifier to the converted character . . . in order to keep track of changes made in the character set” (Office Action, pg. 3), as required by the rejection, it would be rendered inoperable for its intended purpose since the converted data would include the extra identifier, resulting in incorrect information shown on the display module of the recipient device.

The Ho reference recites the following:

In the process of identifying a selected type of internal code in the system, first check whether the value of each character contained in the sent information is within a default range of a specific internal code. All internal codes having values other than the default range are discarded. Then an conversion and an analysis are performed on the qualified information based on the value of internal code thereof. Next, those less frequently appeared and qualified types of internal codes are selected as the types of internal codes while discarding those frequently used words. Then the received information is converted into one having the type of internal code compatible to the recipient device. As a result, a correct information may be shown on display module 5. (col. 4, lines 10-22) (emphasis added).

From the highlighted above, if an identifier was inserted after each byte when transforming the data set as recited in claim 1, the intended function of the Ho reference, an automatic character identification system to “minimize . . . obstruction in information exchange, analyze the received

information based on rules . . . for identifying the . . . internal code used by sender device, and perform a conversion on the information based on the type of internal code for [the recipient device] . . . , thereby showing the correct information at the recipient device,” would be destroyed. (Ho, col. 6, lines 33-40).

Further, there appears no reason in the Ho reference to insert an “identifier” and keep track of the changes made in the character set as the Office Action suggests. The Ho reference provides a system for “errorless information communication between various portable electronic devices.” (Ho, col. 2, lines 6-8). Inserting an identifier after each byte when transforming the data set would serve no purpose since Ho’s reference already provides a way to convert data from a sender device to a recipient device. As indicated in Ho, “[i]n the system of the invention, conversion table is a value table with a variety of types of internal codes of a corresponding character and is stored in ROM.” (Ho, col. 4, lines 28-31). Accordingly, Ho utilizes these conversion tables to convert the data sent from the sender device to a type of internal code that is compatible with the recipient device.

The Office Action asserts that, “it would have been obvious to one with ordinary skill in the art at the time of the invention to insert an identifier to the converted character in Ho’s method in order to keep track of changes made in the character set.” (Office Action, pg. 3). However, since this modification of the Ho reference clearly destroys the purpose or function of the invention disclosed in Ho, one of ordinary skill in the art would not have found a reason to make the claimed modification.

Thus, for this mutually exclusive reason, the Examiner’s burden of factually supporting a *prima facie* case of obviousness has clearly not been met, and the rejection under 35 U.S.C. § 103 with respect to claim 1 should be withdrawn.

2. The Examiner has not shown that all words in the claim have been considered.

MPEP 2143.03 states that “[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art.” Quoting *In re Wilson*, 424 F.2d 1382, 1385 (CCPA 1970). However, in the present matter, the Examiner has not shown that all words in the claim have been considered.

The Ho and Spindel patents cannot be applied to reject claim 1 under 35 U.S.C. § 103 which provides that:

A patent may not be obtained . . . if the differences between the subject matter sought to be patented and the prior art are such that the subject matter *as a whole* would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains. (emphasis added).

Thus, when evaluating a claim for determining obviousness, all limitations of the claim must be evaluated. Since neither Ho nor Spindel teaches “transforming the data set by inserting an identifier after each byte of the one or more bytes, if the first byte is larger than the value,” as recited in claim 1, it is impossible to render the subject matter of claim 1 as a whole obvious, and the explicit terms of the statute cannot be met.

As the Office Action points out, “Ho does not explicitly disclose inserting an identifier after each byte when converting the character.” (Office Action, pg. 3). Applicant respectfully submits that the Spindel reference fails to cure the deficiencies of Ho. More specifically, the Examiner points to col. 5, line 66 through col. 6, line 6 of Spindel as allegedly disclosing such a method step. Applicant respectfully disagrees. The cited passage of Spindel recites the following:

Step Four. If any of the resulting characters are among the non-transmittable characters, they are replaced with two-character sequences, starting with the master character. The first non-transmittable character specified in a user entered

list of non-transmit characters is replaced, wherever it occurs, with the master character followed by the letter A; the second non-transmittable character is replaced by that master-character followed by the letter B, and so on. (emphasis added).

From the highlighted above, Spindel teaches replacing non-transmittable characters with two-character sequences. This is necessary because the non-transmittable characters are being used for specific functions such as the block continue or end character or others. (See Spindel, col. 5, lines 28-31). By doing this, Spindel indicates that “it is possible to utilize the full ASCII character set in data transmission.” (Spindel, col. 5, lines 36-37). Thus, Spindel does not disclose “transforming the data set by inserting an identifier after each byte of the one or more bytes, if the first byte is larger than the value,” as is recited in claim 1.

Accordingly, Ho and Spindel, alone or in combination, doest not teach the method step of “transforming the data set by inserting an identifier after each byte of the one or more bytes, if the first byte is larger than the value.” Therefore, for this mutually exclusive reason, the Examiner’s burden of factually supporting a *prima facie* case of obviousness has clearly not been met, and the rejection under 35 U.S.C. § 103 with respect to claim 1 should be withdrawn.

Independent Claim 11

Independent claim 11 was also rejected as being unpatentable over Ho in view of Spindel. It is clear that the Ho and Spindel references are not properly combinable since, if combined, their intended function is destroyed as previously discussed in claim 1. Thus, the Examiner’s burden of factually supporting a *prima facie* case of obviousness has clearly not been met, and the rejection under 35 U.S.C. § 103 with respect to claim 11 should be withdrawn.

Independent Claim 18

Independent claim 18 was also rejected as being unpatentable over Ho in view of Spindel. Claim 18 was rejected based on a similar rationale that was used to reject independent claim 1. Claim 18 has been amended and recites a similar limitation as in claim 1. Accordingly, Applicants submit that claim 18 is allowable for at least the same reasons set forth above in claim 1. Thus, the Examiner's burden of factually supporting a *prima facie* case of obviousness has clearly not been met, and the rejection of claim 18 under 35 U.S.C. § 103 should be withdrawn.

Dependent Claims 2–10, 12–17, and 19–20

Claims 2–10, claims 12–17, and claims 19–20 depend from, either directly or indirectly, and further limit independent claims 1, 11, and 18 respectively. Accordingly, these claims are allowable for at least the same reasons set forth above in claims 1, 11, and 18. Therefore, Applicant respectfully requests that the Examiner withdraw the rejection and allow these claims.

Further, regarding dependent claims 5 and 20, the Examiner rejected these claims based on the rationale that the claims recite “intended use, the data could be generated by any process.” Applicant respectfully disagrees. For example, claim 5 recites “wherein the data set comprises semiconductor manufacturing data” and claim 20 recites “wherein the first data set comprises semiconductor manufacturing data.” Accordingly, claims 5 and 20 further limit the data set to comprise of semiconductor manufacturing data, a certain type of data. Therefore, claims 5 and 20 are proper dependent claims that are narrower than the claims from which they depend from.

Conclusion

For at least the reasons set forth above, Applicant submits that the pending claims 1–20 are in condition for allowance. Accordingly, Applicant respectfully requests that the Examiner withdraw the outstanding rejections and issue a formal notice of allowance.

The Office Action contains characterizations of the claims and the related art to which Applicant does not necessarily agree. Unless expressly noted otherwise, Applicant declines to subscribe to any statement or characterization in the Office Action.

The Examiner is invited to call the undersigned at the below-listed telephone number if a telephone conference would expedite or aid the prosecution and examination of the application.

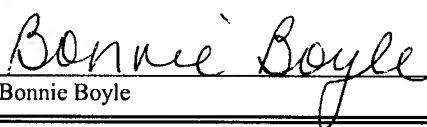
Respectfully submitted,



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I hereby certify that this correspondence is being filed with the U.S. Patent and Trademark Office via EFS-Web on <u>November 16, 2007</u> .
 Bonnie Boyle